PATENT

Atty Docket No.: 70019413-1
App. Ser. No.: 10/773,910

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the claim amendments and following remarks. By virtue of the amendments above, Claims 1 and 7 have been amended and Claim 4 has been canceled without prejudice or disclaimer of the subject matter contained therein. Currently, therefore, Claims 1-3 and 5-7 are pending in the present application, of which, Claims 1 and 7 are independent.

No new matter has been introduced by way of the claim amendments; entry thereof is therefore respectfully requested.

Information Disclosure Statement

The indication that the Information Disclosure Statement filed on February 5, 2004 has been considered is noted with appreciation.

Drawings

The indication that the drawings submitted on February 5, 2004 have been accepted is also noted with appreciation.

Claim Rejection Under 35 U.S.C. § 112, second paragraph

The Official Action sets forth a rejection of Claim 4 as allegedly being indefinite. Claim 4 has been cancelled without prejudice or disclaimer of the subject matter contained therein. Accordingly, the rejection of Claim 4 is considered moot and the Examiner is respectfully requested to withdraw the rejection of Claim 4.

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Claim Rejection Under 35 U.S.C. §102

The test for determining if a reference anticipates a claim, for purposes of a rejection under 35 U.S.C. § 102, is whether the reference discloses all the elements of the claimed combination, or the mechanical equivalents thereof functioning in substantially the same way to produce substantially the same results. As noted by the Court of Appeals for the Federal Circuit in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. § 102, the Court stated:

> Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Therefore, if the cited reference does not disclose each and every element of the claimed invention, then the cited reference fails to anticipate the claimed invention and, thus, the claimed invention is distinguishable over the cited reference.

The Official Action sets forth a rejection of Claims 1-4 and 7 as allegedly being anticipated by the disclosure contained in U.S. Patent No. 5,743,522 to Rubscha et al. This rejection is respectfully traversed because Rubscha et al. fails to disclose the invention as set forth in Claims 1-4 and 7.

The Official Action asserts that the actuator 32 and the optical switch 39 of Rubscha et al. read on the probe and detector of the claimed invention. As shown, for instance, in Figure 4 of Rubscha et al., the actuator 32 and the optical switch 39 are positioned beneath a tray 12 for supporting sheets. In this regard, the actuator 32 and the optical switch 39 are located on the same side of the sheets when the sheets are positioned on the tray 12.

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In contrast, independent Claims 1 and 7 have been amended to include that the probe and the detector are located on opposite sides of media when the media stack tray has a loaded status. As such, Rubscha et al. fails to disclose each and every element of the invention as claimed in Claims 1 and 7 of the present invention and therefore cannot anticipate these claims. Accordingly, the Examiner is respectfully requested to withdraw the rejection of Claims 1 and 7 and to allow these claims.

Claims 2 and 3 are also allowable over Rubscha et al. at least by virtue of their dependencies upon allowable Claim 1.

Claim Rejection Under 35 U.S.C. §103

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in MPEP § 706.02(j):

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation